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EXAMINER

ONEILL, MICHAEL W

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,879

Applicant(s)

OLES ET AL.

Examiner

Michael O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 13-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are directed to a subcombination of a process to determine whether there has been a breached

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-16 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The above identified claims are not being treated under the prior art for the reasoning of constructive election given above; however, in order to advance prosecution the Examiner will inform the Applicant of the non-art issues raised by these claims.

Response to Amendment

The amendment filed 5-13-05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The

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added material which is not supported by the original disclosure is as follows: the new limitations in claim 1: wherein the obtaining of the images associated with said person and the exterior and the interior of the gaming machine are performed simultaneously. The new limitations in claim 13: simultaneously obtaining current facial image information of a person using the card at the gaming machine and obtaining at least one image of an activity associated with the person and the exterior of the gaming machine; and comparing the first facial image information stored on the card with the current facial image information of the person using the card at the gaming machine to confirm that the person using the card is the party to whom the card was issued and further confirming that security within the interior of the gaming machine has not been breached.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the new limitations in claim 1: obtaining at least one image of an activity associated with said person and the exterior of the gaming machine; obtaining at least one image of an activity associated with the interior of

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the gaming machine and wherein the obtaining of the images associated with said person and the exterior and the interior of the gaming machine are performed simultaneously. The new limitations in claim 13: simultaneously obtaining current facial image information of a person using the card at the gaming machine and obtaining at least one image of an activity associated with the person and the exterior of the gaming machine; and comparing the first facial image information stored on the card with the current facial image information of the person using the card at the gaming machine to confirm that the person using the card is the party to whom the card was issued and further confirming that security within the interior of the gaming machine has not been breached must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. The following limitations are not mentioned in the originally filed written description of the invention:

The new limitations in claim 1: obtaining at least one image of an activity associated with said person and the exterior of the gaming machine; obtaining at least one image of an activity associated with the interior of the gaming machine and wherein the obtaining of the images associated with said person and the exterior and the interior of the gaming machine are performed simultaneously. And, the new limitations in claim 13: simultaneously obtaining current facial image information of a person using the card at the gaming machine and obtaining at least one image of an activity associated with the person and the exterior of the gaming machine; and comparing the first facial image information stored on the card with the current facial image information of the person using the card at the gaming machine to confirm that the person using the card is the party to whom the card was issued and further confirming that security within the interior of the gaming machine has not been breached.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert '806; Cumbers '876; Soltys et al. '848; and DeBan et al. '103, as applied in the Office actions on the merits mailed, 02-11-05 and 08-11-2004, further in view of Yoshida et al., USPN 5,253,167.

What the four former references disclose, teach and suggest to those skilled in the art can be found in the above identified Office actions on the merits and is incorporated herein. With respect to the newly added limitations presented in this amendment to the claims, e.g. claim 1, 10, 11 and 12, Yoshida et al. clearly teaches the use of internal cameras, see the figures, and the system would be capable of simultaneously image capture because as taught in Soltys et al. and Yoshida et al. there are plural camera and in particular Yoshida et al.'s plural cameras are connected to a single control unit (20) and in col. 2:49-52 the reference states: "the picture imaged by the cameras (10) and (13) are transmitted through a communication control unit (20) and a picture transmission line (30) to the picture display (3) and displayed thereon." Thus, it would have

been obvious to one of ordinary skill in the art to apply the teachings to Yoshida et al. to the discloses invention disclose, taught and suggest by the four former references in order to identify the user of the system at taught by these references.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert '806; Cumbers '876; Soltys et al. '848; and DeBan et al. '103, as applied in the Office actions on the merits mailed, 02-11-05 and 11-01-2004, further in view of Yoshida et al. '167 as applied to claim 1 above, and further in view of Alden '766.

What Alden teaches and suggests to those skilled in the art and how it makes this claim obvious to those skilled in the art has been discussed in the Office action of 08-11-2004 and is incorporated herein.

Response to Arguments

Applicant's arguments filed 5-13-05 have been fully considered but they are not persuasive. Some of the remarks have been address with the new reference Yoshida et al. vis-à-vis the new claim limitations. The remaining remarks are similar to the remarks made against the 103 rejection in the past: lack of establishing a prima facie case; lack of motivation to combine and impermissible use of hindsight reconstruction. The Examiner

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respectfully disagrees with the Applicant that the prima facie case has not been met; no motivation to combine or there has been impermissible hindsight reconstruction. The Examiner position is that the Applicant is consistently viewing the references individually rather than as the whole when comparing the claimed limitations to the prior art. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding motivation, the Examiner's position is that able motivation has been stated in the rejection. It appears that the Applicant does not appreciate the motivation provided or the Applicant has a different motivation for Applicant's invention. With respect to the former, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Regarding the latter, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

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invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, anyone of ordinary skill in the art would see the need for security whereby the system owner as the capability of knowing who is access their system and whether said access is an authorized access or unauthorized. The prior art of record suggests such motivations through its teachings and suggestion to those of ordinary skill in the art. Regarding the hindsight issue: it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Any hindsight that has been done by the Examiner has been only with the knowledge of one of ordinary skill in the art. For example, one skilled in the art understands the need for security measures. As shown by the art, one way of securing systems is with the use of camera to

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monitor. One skilled in the art understand the need to determine who can have access or is authorized to use a system. As shown by the art, way of determining who can access a system is through metrics. In sum, everything the Applicant has disclosed in combining together and is claiming has been in the art for years in one form or the other.

Conclusion

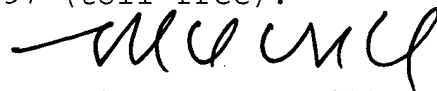
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Tuesday through Friday 8:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael O'Neill
Primary Examiner
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